

Docket No.: PF-0208-1 DIV

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By: Kathleen K. Muto
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Hillman et al.

Title: NOVEL HUMAN INTEGRAL MEMBRANE PROTEIN

Serial No.: 09/207,161

Filing Date: December 7, 1998

Examiner: Carlson, K.

Group Art Unit: 1653

Box Non-Fee Amendment
Assistant Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT UNDER 35 U.S.C. 121

Sir:

This is a timely response to the Restriction Requirement mailed January 19, 2000 (Paper Number 6) in the above-referenced application. The Examiner required that Applicants elect one of the following inventions:

- Group I: Claims 1 and 11;
- Group II: Claims 12;
- Group III: Claim 13;
- Group IV: Claim 14 and 15;
- Group V: Claims 16;
- Group VI: Claim 17 and 18.

Claims 1 and 11-18 are pending.

Applicants elect the claims of Group I (claims 1 and 11) with traverse. Applicants submit that the invention encompassed by the claim of Group II (drawn to a purified antibody) could be

examined at the same time as the invention encompassed by the claims of Group I (drawn to a substantially purified polypeptide). For example, a search of the prior art to determine the novelty of an antibody that binds to the polypeptide of claim 1 would substantially overlap the search of the prior art to determine the novelty of the polypeptide of claim 1. Applicants also submit that the invention encompassed by the claims of Group III (drawn to a purified agonist) and Group IV (drawn to a purified antagonist) could also be examined at the same time as the invention encompassed by the claims of Group I. For example, a search of the prior art to determine the novelty of purified agonists and antagonists of the polypeptide of claim 1 would substantially overlap the search of the prior art to determine the novelty of the polypeptide of claim 1.

Applicants respectfully submit that examination of new claim 19 (drawn to a method of screening for a compound that specifically binds to the polypeptide of claim 1) and new claim 20 (drawn to a method of screening for a compound that modulates the activity of the polypeptide of claim 1) along with the elected claims of Group I is proper, as method claims 19 and 20 cover the same scope as the elected product claims of Group I (see, for example, M.P.E.P. § 821.04 and the Commissioner's Notice in the Official Gazette of March 26, 1996, entitled "Guidance on Treatment of Product and Process Claims in Light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)" which sets forth the rules for rejoinder of method claims covering the same scope as allowed product claims).

Applicants further submit that the method claims of Group VI should have been rejoined and examined with the allowed product claim (claim 2) from which it originally depended during prosecution of the parent application (U.S. Serial Number 08/791,338, filed January 31, 1997, now U.S. Patent Number 5,889,170). As lack of rejoinder of claims 17 and 18 in the parent application creates an undue burden on the Applicants by necessitating the filing, prosecution, and maintenance of an additional application in this family, Applicants respectfully submit that examination of claims 17 and 18 along with the claims of Group I in the instant application would mitigate this burden.

Accordingly, because the searches required to identify prior art relevant to the claims of Groups I, II, III and IV would substantially overlap; the claims of Group VI should have been rejoined and examined with the allowed claims of the parent application; and new claims 19-20

are method claims which are properly examined with the product claims of elected Group I; Applicants respectfully submit that examination of claims 1, 11-15, and 17-20 would not pose a serious burden. Thus, Applicants request reconsideration and withdrawal of the Restriction Requirement and examination of claims 1, 11-15, and 17-20.

In the event that the Examiner determines that the Restriction Requirement should be maintained, Applicants elect the claims of Group I, again with traverse. Applicants reserve the right to prosecute the non-elected claims in subsequent divisional applications.

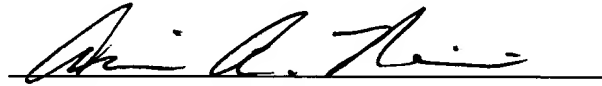
Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Incyte Pharmaceuticals, Inc. Deposit Account No. **09-0108**.

This form is enclosed in duplicate.

Respectfully submitted,

INCYTE PHARMACEUTICALS, INC.

Date: 2/22/00



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